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Subject: U.S. Trademark Application Serial No. 88728723 - GOLDN PAYDIRT - 2019GPD1216 - EXAMINER BRIEF

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**United States Patent and Trademark Office (USPTO)**

**U.S. Application Serial No.** 88728723

**Mark:** GOLDN PAYDIRT

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**Applicant:** Walrus Rodeo LLC

**Reference/Docket No.** 2019GPD1216

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**EXAMINING ATTORNEY'S APPEAL BRIEF**

**INTRODUCTION**

Walrus Rodeo LLC (hereafter "Applicant") appeals the Trademark Examining Attorney's partial refusal to register the mark "GOLDN PAYDIRT" for "Gold; Gold bullion; Gold ore; Gold and its alloys; Gold, unworked or semi-worked; Gold, unwrought or beaten; Palladium; Palladium and its alloys; Precious metals; Precious metals and their alloys; Precious metals, unwrought or semi-wrought; Silver; Silver bullion; Silver ore; Alloys of precious metal; Platinum; Unworked or semi-worked gold" and

“Mining exploration and mineral exploration services in the field of metals; Geological prospecting” in International Classes 014 and 042 because the proposed mark is merely descriptive of a feature of the identified goods and services.

### **FACTS**

On December 16, 2019, Applicant applied for registration on the Principal Register for the standard character mark “GOLDN PAYDIRT” for “Gold; Gold bullion; Gold ore; Gold and its alloys; Gold, unworked or semi-worked; Gold, unwrought or beaten; Palladium; Palladium and its alloys; Precious metals; Precious metals and their alloys; Precious metals, unwrought or semi-wrought; Silver; Silver bullion; Silver ore; Alloys of precious metal; Platinum; Unworked or semi-worked gold” in International Class 014, “Hats; Hats for infants, babies, toddlers and children; Hoodies; Long johns; Long-sleeved shirts; Overalls; Sweat bands; Sweat pants; Sweat shirts; Sweat shorts; T-shirts; Underwear; Baseball caps and hats; Bib overalls; Bucket hats; Cowboy hats; Disposable underwear; Graphic T-shirts; Hooded sweat shirts; Long underwear; Short-sleeved or long-sleeved t-shirts; Sports caps and hats; Stocking hats; Thermal underwear; Thong underwear; Women's hats and hoods; Working overalls” in International Class 025, “Amusement park and theme park services; Amusement park services; Entertainment in the nature of a water park and amusement center; Entertainment in the nature of an amusement park ride; Entertainment services in the nature of an amusement park attraction, namely, a themed area; Entertainment services in the nature of an amusement park show; Entertainment services, namely, arranging and conducting special events at an amusement park; Entertainment services, namely, arranging for ticket reservations for amusement park attractions; Providing amusement parks; Provision of information relating to amusement park shows” in International Class 041, and “Mining exploration and mineral exploration services in the field of metals; Geological prospecting” in International Class 042.

In the first Office action issued on March 20, 2020, the Trademark Examining Attorney refused registration on the Principal Register under Trademark Act Section 2(e)(1) 15 U.S.C. §1052(e)(1) on the ground that the Applicant's mark is merely descriptive of the goods and services identified in the application in International Classes 014 and 042. Applicant was also given advisories about Applicant's response options, the Supplemental Register, and partial abandonment.

On September 27, 2020, Applicant filed a Petition to Revive an Abandoned Application and a Response to Office action. The application was revived on September 28, 2020. Applicant's Response to Office action contested the grounds for partial refusal and asserted therein that Applicant's mark is not merely descriptive of Applicant's goods and services. After careful consideration of Applicant's response, the Trademark Examining Attorney determined that Applicant's arguments were not persuasive. The partial refusal of registration under Trademark Act Section 2(e)(1) was maintained and made final on January 27, 2021.

On June 8, 2021, Applicant filed a Notice of Appeal to the Trademark Trial and Appeal Board, and Applicant filed an appeal brief on October 11, 2021.

For the reasons set forth below, the Trademark Examining Attorney respectfully requests that the Trademark Trial and Appeal Board affirm the partial refusal to register the proposed mark under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1).

#### **ISSUE ON APPEAL**

The sole issue on appeal is whether the proposed mark "GOLDN PAYDIRT" is merely descriptive of a feature of "Gold; Gold bullion; Gold ore; Gold and its alloys; Gold, unworked or semi-worked; Gold, unwrought or beaten; Palladium; Palladium and its alloys; Precious metals; Precious metals and their alloys; Precious metals, unwrought or semi-wrought; Silver; Silver bullion; Silver ore; Alloys of precious

metal; Platinum; Unworked or semi-worked gold” and “Mining exploration and mineral exploration services in the field of metals; Geological prospecting” in International Classes 014 and 042, under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1).

## **ARGUMENT**

### **I. Under Section 2(e)(1) of the Trademark Act, Applicant’s Mark is Merely Descriptive of Applicant’s Identified Goods and Services**

A mark is merely descriptive if it describes a feature of an Applicant’s goods and services. TMEP §1209.01(b); *see, e.g., In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543 (1920)).

Applicant has applied to register the mark “GOLDN PAYDIRT” for “Gold; Gold bullion; Gold ore; Gold and its alloys; Gold, unworked or semi-worked; Gold, unwrought or beaten; Palladium; Palladium and its alloys; Precious metals; Precious metals and their alloys; Precious metals, unwrought or semi-wrought; Silver; Silver bullion; Silver ore; Alloys of precious metal; Platinum; Unworked or semi-worked gold” and “Mining exploration and mineral exploration services in the field of metals; Geological prospecting.” An examination of the definitional evidence of record, Internet evidence showing common usage of the terms, and Applicant’s own website demonstrates that the mark is merely a combination of two descriptive terms that are descriptive of Applicant’s goods and services and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods and services.

#### **A. The Evidence Shows that “GOLDN PAYDIRT” is Merely Descriptive of Applicant’s Goods and Services**

“GOLDN PAYDIRT” is merely descriptive of Applicant’s goods and services in International Classes 014 and 042 because Applicant’s goods include paydirt that is golden in color and also contains gold, and Applicant’s services include mining, mineral, and geological services that are rendered to obtain the golden paydirt.

The determination of whether a mark is merely descriptive is made in relation to an applicant’s goods and services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b). “Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

First, the dictionary evidence shows that “GOLDN PAYDIRT” is merely descriptive of Applicant’s goods and services because Applicant’s paydirt is golden in color and also contains gold, and Applicant’s services include mining, mineral, and geological services to obtain the golden paydirt.

- The evidence from Merriam-Webster shows that “GOLDEN” means “consisting of, relating to, or containing gold.” See March 20, 2020 Office action, TSDR pages 11 – 17.
- The evidence from Merriam-Webster shows that “PAY DIRT” means “earth or ore that yields a profit to a miner.” See March 20, 2020 Office action, TSDR pages 18 – 22.
- The evidence from Merriam-Webster shows that “MINERALS” are “a naturally occurring solid substance (as diamond, gold, or quartz) that is not of plant or animal origin.” See March 20, 2020 Office action, TSDR pages 23 – 29.

Next, Applicant's website shows that "GOLDN PAYDIRT" is merely descriptive of Applicant's goods and services. Specifically, Applicant's website shows that Applicant sells paydirt that is golden in color and contains gold and minerals. Additionally, Applicant's website shows that Applicant's goods are obtained from gold mining services.

- The evidence from Applicant's website shows that Applicant sells paydirt that contains gold. *See* March 20, 2020 Office action, TSDR pages 2 – 10.
- The evidence from Applicant's website shows that Applicant's goods are golden in color. *See* March 20, 2020 Office action, TSDR pages 2 – 10.
- The evidence from Applicant's website shows that paydirt can include other things such as rocks and minerals. *See* March 20, 2020 Office action, TSDR pages 2 – 10.
- The evidence from Applicant's website shows that "The GOLDN PAYDIRT we offer is mined, created and comes to you directly from hard working GOLD MINERS!!" *See* March 20, 2020 Office action, TSDR pages 2 – 10.

Further, the attached evidence from third party websites also shows that "GOLDN PAYDIRT" is merely descriptive of Applicant's goods and services. Specifically, the evidence from Gold Rush Trading Post, Felix's Paydirt Gourmet Gold, Gold Fever Prospecting, Constellation Mining Company, Lynch Mining, Goldbay, and Crisson Gold Mine shows that when consumers encounter paydirt in the marketplace, it is commonly golden in color and contains gold. Additionally, the evidence from McDaniels Mining, Prestige Minerals and Gems, Mines Magazine, Proactive, Volvo, and Geology.com shows that mining services, mining and mineral exploration services, and geological prospecting services are all commonly used in Applicant's industry to find gold and golden paydirt.

- The evidence from Gold Rush Trading Post shows that they provide paydirt with gold in it. *See January 27, 2021 Office action, TSDR pages 2 – 4.*
- The evidence from Felix’s Paydirt Gourmet Gold shows that they provide paydirt with gold in it. *See January 27, 2021 Office action, TSDR pages 5 – 10.*
- The evidence from Gold Fever Prospecting shows that they provide paydirt with gold in it that is golden in color. *See January 27, 2021 Office action, TSDR pages 11 – 16.*
- The evidence from Constellation Mining Company shows that they provide gold panning paydirt that is golden in color. *See January 27, 2021 Office action, TSDR pages 17 – 18.*
- The evidence from Lynch Mining shows that they provide paydirt with gold in it that is golden in color. *See January 27, 2021 Office action, TSDR pages 19 – 34.*
- The evidence from Goldbay shows that they provide paydirt with gold in it that is golden in color. *See January 27, 2021 Office action, TSDR pages 35 – 37.*
- The evidence from Crisson Gold Mine shows that they provide gold ore concentrates with gold and minerals in it that is golden in color. *See January 27, 2021 Office action, TSDR pages 38 – 42.*
- The evidence from McDaniels Mining shows that they provide mining services in the field of metals in order to find gold paydirt. This evidence also shows that they sell the paydirt they mine that has gold in it and that it is golden in color. *See January 27, 2021 Office action, TSDR pages 43 – 47.*
- The evidence from Prestige Minerals and Gems shows that they provide mining services in order to find precious metal ore, paydirt, gold nuggets, diamond ore, and a variety of minerals and gemstones. This evidence also shows that they sell the paydirt they mine



that has gold in it and that it is golden in color. *See* January 27, 2021 Office action, TSDR pages 48 – 51.

- The evidence from Mines Magazine shows that mining exploration, mineral exploration, and geological prospecting services can be used to find gold, precious metals, minerals, and “paydirt” that contains gold. *See* January 27, 2021 Office action, TSDR pages 52 – 60.
- The evidence from Proactive shows that mining services can be used to find gold, silver, and precious metals “paydirt”. *See* January 27, 2021 Office action, TSDR pages 61 – 68.
- The evidence from Volvo shows that mining and prospecting services can be used to find gold “paydirt”. *See* January 27, 2021 Office action, TSDR pages 69 – 73.
- The evidence from Geology.com shows that mining exploration, mineral exploration, and geological prospecting services can be used to find gold. *See* January 27, 2021 Office action, TSDR pages 74 – 83.

Therefore, “GOLDN PAYDIRT” is merely descriptive of Applicant’s goods that include paydirt with gold and other minerals in it that is golden in color, and “GOLDN PAYDIRT” is also merely descriptive of Applicant’s mining and geological services that are rendered to find gold, precious metals, minerals, and paydirt that is golden in color.

The Trademark Examining Attorney notes that “GOLDN” is a misspelling of “GOLDEN”; however, this does not affect the descriptiveness analysis. A novel spelling or an intentional misspelling that is the phonetic equivalent of a merely descriptive word or term is also merely descriptive if purchasers would perceive the different spelling as the equivalent of the descriptive word or term. *See In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 526 & n.9, 205 USPQ 505, 507 & n.9 (C.C.P.A. 1980) (holding “QUIK-PRINT,” phonetic spelling of “quick-print,” merely descriptive of printing and photocopying services); *In*

*re Calphalon Corp.*, 122 USPQ2d 1153, 1163 (TTAB 2017) (holding “SHARPIN”, phonetic spelling of “sharpen,” merely descriptive of cutlery knife blocks with built-in sharpeners); *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009) (holding “URBANHOUSING,” phonetic spelling of “urban” and “housing,” merely descriptive of real estate services); TMEP §1209.03(j).

Here, although “GOLDN PAYDIRT” is made up of two different words, Applicant’s mark as a whole is still merely descriptive of Applicant’s goods and services. Generally, if the individual components of a mark retain their descriptive meaning in relation to the goods and services, the combination results in a composite mark that is itself descriptive and not registrable. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1516 (TTAB 2016) (citing *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002)); TMEP §1209.03(d); *see, e.g., In re Cannon Safe, Inc.*, 116 USPQ2d 1348, 1351 (TTAB 2015) (holding SMART SERIES merely descriptive of metal gun safes); *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs, and pillows).

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods and services is the combined mark registrable. *See In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013).

In this case, both the individual components and the composite result are descriptive of Applicant’s goods and services and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods and services.

Specifically, taken as a whole, “GOLDN PAYDIRT” is still merely descriptive of Applicant’s goods that include paydirt with gold and other minerals in it that is golden in color, and Applicant’s mining and geological services that are rendered to find gold, precious metals, minerals, and golden paydirt. An

applicant may not claim exclusive rights to terms that others need to use to describe their goods and services in the marketplace.

**B. Applicant's Arguments Are Unpersuasive**

Applicant's arguments have been considered but have been found to be unpersuasive for the reasons set forth below.

Applicant argues that Applicant's mark is suggestive. *See* September 27, 2020 Petition to Revive and Response to Office action, TSDR pages 2 – 5. Further, Applicant argues that the Trademark Examining Attorney has not articulated one attribute of Applicant's goods that makes Applicant's mark descriptive. *See* Applicant's Appeal Brief dated October 11, 2021, page 4. A mark is suggestive if some imagination, thought, or perception is needed to understand the nature of the goods and services described in the mark; whereas a descriptive term immediately and directly conveys some information about the goods and services. *See Stoncor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 1332, 111 USPQ2d 1649, 1652 (Fed. Cir. 2014) (citing *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251-52, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012)); TMEP §1209.01(a). Here, "GOLDN PAYDIRT" is not suggestive because "GOLDN PAYDIRT" immediately conveys information about Applicant's goods and services, which is that they provide paydirt that is golden in color and contains gold, and that they also provide the related mining, mineral, and geological services to obtain the golden paydirt. Therefore, Applicant's mark is merely descriptive of Applicant's goods and services.

Next, Applicant argues that "GOLDEN" and "PAYDIRT" have other meanings that are not descriptive. *See* September 27, 2020 Petition to Revive and Response to Office action, TSDR pages 4 – 5. However, descriptiveness is considered in relation to the relevant goods and services. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir.

2012). “That a term may have other meanings in different contexts is not controlling.” *Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at \*5 (TTAB 2019) (citing *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1598 (TTAB 2018)); TMEP §1209.03(e). “It is well settled that so long as any one of the meanings of a term is descriptive, the term may be considered to be merely descriptive.” *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1590 (TTAB 2018) (quoting *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984)). Here, since one of the meanings of “GOLDEN” is descriptive, and one of the meanings of “PAYDIRT” is descriptive, these terms are descriptive.

Similarly, Applicant argues that its goods also include silver, and other precious metals, which are not golden in color. See September 27, 2020 Petition to Revive and Response to Office action, TSDR page 4. However, a mark does not need to be merely descriptive of all the goods or services specified in an application. *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Franklin Cnty. Historical Soc’y*, 104 USPQ2d 1085, 1089 (TTAB 2012). “A descriptiveness refusal is proper ‘if the mark is descriptive of any of the [goods or] services for which registration is sought.’” *In re The Chamber of Commerce of the U.S.*, 675 F.3d at 1300, 102 USPQ2d at 1219 (quoting *In re Stereotaxis Inc.*, 429 F.3d 1039, 1040, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005)). Since “GOLDEN” is descriptive for at least some of Applicant’s goods and services, the descriptiveness refusal is proper.

Further, Applicant argues that Applicant’s goods are not golden in color and that they do not pay. See Applicant’s Appeal Brief dated October 11, 2021, pages 1, 3, 5, 7. However, Applicant’s website clearly shows that applicant’s goods are golden in color and include real gold that yields a profit. See March 20, 2020 Office action, TSDR pages 2 – 10. Therefore, this argument is unpersuasive.

Additionally, Applicant challenges some of the Trademark Examining Attorney’s Internet evidence of record. See Applicant’s Appeal Brief dated October 11, 2021, pages 5 – 7. For purposes of

evaluating a trademark, material obtained from the Internet is generally accepted as competent evidence. *See In re Bayer Aktiengesellschaft*, 488 F.3d 960, 966, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007); *In re Reed Elsevier Props., Inc.*, 482 F.3d 1376, 1380, 82 USPQ2d 1378, 1381 (Fed. Cir. 2007); TBMP §1208.03; TMEP §710.01(b).

Next, Applicant argues that Applicant's mark is incongruent, and therefore suggestive. *See* Applicant's Appeal Brief dated October 11, 2021, page 3. However, Applicant has not explained this alleged incongruity, and the evidence of record shows that both the individual components and the composite result of Applicant's mark are descriptive of Applicant's goods and services and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods and services. Therefore, taken as a whole, "GOLDN PAYDIRT" is merely descriptive of Applicant's goods and services.

Further, Applicant argues that the Office has allowed trademarks for the wording "JACKPOT", and therefore, Applicant's mark should be allowed to register. *See* Applicant's Appeal Brief dated October 11, 2021, page 4. First, Applicant had not provided registration numbers or any other reference to these alleged "JACKPOT" registrations. To make third party registrations part of the record, an applicant must submit copies of the registrations, or the complete electronic equivalent from the USPTO's automated systems, prior to appeal. *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2064 (TTAB 2013); TBMP §1208.02; TMEP §710.03. Accordingly, these registrations will not be considered. Second, even if these registrations were of record, the wording "JACKPOT" does not appear in Applicant's mark, and therefore, these registrations would not be relevant to the determination of descriptiveness of Applicant's mark.

Finally, Applicant argues that any doubt should be resolved in favor of Applicant. *See* Applicant's Appeal Brief dated October 11, 2021, page 4. However, in the present case, the evidence of record leaves no doubt that the mark is merely descriptive.

## CONCLUSION

Based on the foregoing and evidence of record, the applied-for mark “GOLDN PAYDIRT” is merely descriptive of a feature of Applicant’s “Gold; Gold bullion; Gold ore; Gold and its alloys; Gold, unworked or semi-worked; Gold, unwrought or beaten; Palladium; Palladium and its alloys; Precious metals; Precious metals and their alloys; Precious metals, unwrought or semi-wrought; Silver; Silver bullion; Silver ore; Alloys of precious metal; Platinum; Unworked or semi-worked gold” and “Mining exploration and mineral exploration services in the field of metals; Geological prospecting.” In the context of Applicant’s goods and services, the average consumer is likely to find that Applicant’s applied-for mark, “GOLDN PAYDIRT” merely describes a feature of these goods and services, namely, that they provide paydirt that is golden in color and also contains gold, and that they include mining, mineral, and geological services that are rendered to obtain the golden paydirt.

Accordingly, it is respectfully submitted that the partial refusal to register the proposed mark under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1) be affirmed.

Respectfully submitted,

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